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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,768

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Matt Clark

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EXAMINER

LOVEL, KIMBERLY M

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,768

Applicant(s)

CLARK ET AL.

Examiner

Kimberly Lovel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-15 are rejected.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 10, items 1025 and 1045; Fig 11a, item 1110A; Fig 11b, item 1110B; Fig 11c, item 1110C; Fig 11d, item 1110D; and Fig 13c, item 1300C. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

3. Claim 1 objected to because of the following informality:

The claim 1, line 5 recites "the wireless mobile device". The limitation lacks antecedent basis.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPub 2002/0123359 to Wei et al (hereafter Wei et al).

Referring to claim 1, Wei et al disclose a computer server implemented method of providing information to a client device (see [0032], lines 3-6 – the SMS server is connected to a mobile phone; the SMS server is considered to represent the *computer server*; the mobile phone is considered to represent a *client device*), the method comprising:

receiving a request for a service (see [0032]-[0037]);

directing said request to a remote service provider (see [0032], lines 3-6 – the internet is considered to represent a *remote service provider*);

adapting any response to said request to the wireless mobile device utilizing a predetermined feature-based template having one or more HTML pages, text pages, images, buttons, actions, calendars, favorites and data structures (see [0037] and [0038]); and

providing said adapted response to the wireless mobile device for depiction within a response adaptable environment (see [0038] and [0042]).

**Referring to claim 2**, Wei et al disclose the method of claim 1, wherein said adapted response comprises a solution to said request (see [0042] – results from the internet search is considered to represent *a solution to said request*).

**Referring to claim 3**, Wei et al disclose the method of claim 2, wherein said adapted response comprises a plurality of solutions to said request (see [0042] – results is considered to represent *a plurality of solutions*).

**Referring to claim 4**, Wei et al discloses the method of claim 3, wherein said adapted response further comprises an index to said plurality of solutions (see [0038], line 1).

**Referring to claim 5**, Wei et al discloses the method of claim 1, wherein said adapted response comprises supplemental information related to said request (see [0070], lines 7-9 – member's names and age is considered to represent supplemental information since it is consolidated data).

**Referring to claim 6**, Wei et al discloses the method of claim 5, wherein said supplemental information is delivered to the client device prior to receiving a solution at

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the client device (see [0071] – the sports club can create a query based on the consolidated data).

**Referring to claim 9**, Wei et al discloses the method of claim 1, wherein adapting any response to said request comprises localizing said response (see [0033]-[0034] – using the customer security number and the merchant UIN is considered to represent localizing the response since the response is for a particular customer).

**Referring to claim 10**, Wei et al discloses the method of claim 1, wherein if an adapted solution response is provided before an adapted supplemental response, then the supplemental response is not provided to the wireless mobile device (see [0070], lines 1-7).

**Referring to claim 11**, Wei et al discloses the method of claim 1, wherein said adapted response comprises a solution command selectable by a user (see [0093] – a user selects to purchase a PDA).

**Referring to claim 12**, Wei et al discloses the method of claim 11, wherein said solution command, on selection, requests service from a vendor other than the vendor who caused the solution command to be include as part of the adapted response (see [0093]-[0110] – when checking out, credit card information is validated by iPayment's server; iPayment is considered to represent a second vendor).

**Referring to claim 13**, Wei et al discloses the method of claim 1, wherein the service is associated with a first feature, and said adapted response comprises updates to a data item of a database associated with a second feature (see [0079] – the first feature is considered to be represented by broadcasting target messages; the second

feature is considered to be represented entering user profile information into the database).

**Referring to claim 14**, Wei et al discloses a computer readable medium containing computer executable instructions for performing the actions of the method of any of claims 1-2,5,7,9-13 (see [0030]).

**Referring to claim 15**, Wei et al discloses an apparatus having a processor and a memory coupled to the processor containing computer executable instructions operative to perform the actions of the method of any of claims 1-2,5,7,9-13 (see [0032] – the SMS server is considered to represent the *apparatus*).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2002/0123359 to Wei et al as applied to claim 1 above, and further in view of the Background of the Invention of US PGPub 2002/0107891 to Leamon et al (hereafter Leamon et al).

**Referring to claim 7**, Wei et al teach a response to a request. However, Wei et al fail to explicitly teach the further limitation of the request wherein any response to said request is received in an XML format. Leamon et al teach a method of responding to a request including the further limitation of the request. In particular, Leamon et al teaches a method similar to that of claim 1, wherein any response to said request is received in an XML format (see [0006]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Leamon et al's method receiving responses to requests in the form of XML documents with Wei et al's method. One would have been motivated to do so since mobile phones communicate with WML (Wei et al: see [0003], lines 8-9).

**Referring to claim 8**, the combination of Wei et al and Leamon et al discloses the method of claim 7, wherein adapting any response to said request comprises processing any XML formatted response via an XSLT (Leamon et al: see [0006]).



***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US PGPub 2002/0073076 to Xu et al titled "System and Method for Enabling Off-line Database Functionality"
- US Patent No 6,356,905 to Greshman et al titled "System, Method and Article of Manufacture for Mobile Communication Utilizing an Interface Support Network"

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-2750. The examiner can normally be reached on 8:00 - 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly Lovel  
Examiner  
Art Unit 2167

kml  
14 April 2006

BC

  
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